



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/581,511	10/06/2000	Raymond Andersen	P108281-0000	6795

7590 12/11/2002
Arent Fox Kintner Plotkin & Kahn
Suite 600
1050 Connecticut Avenue NW
Washington, DC 20036-5339

EXAMINER

LUKTON, DAVID

ART UNIT	PAPER NUMBER
----------	--------------

1653

DATE MAILED: 12/11/2002

16

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/581,511

Applicant(s)

Andersen

Examiner

David Lukton

Art Unit

1653



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on Sep 26, 2002
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 22-74 is/are pending in the application.
- 4a) Of the above, claim(s) 74 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 22-73 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s). 14 6) ☐ Other:

Pursuant to the directives of paper No. 15 (filed 9/26/02), claims 1-21 have been cancelled, and claims 22-74 added. Claims 22-74 are pending. Claim 74 is withdrawn from consideration at this time.

Applicants' arguments filed 9/26/02 have been considered and found persuasive in part. The rejection of claim 1 over Molteni (US 4,048,305) is withdrawn.

✱

An abstract is required, and does not appear to have been submitted.

✱

The following is a quotation of the first paragraph of 35 U.S.C. §112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it in such full, clear, concise and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 22-73 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Claim 22 now recites the following:

“if R₈ is hydrogen, Y may only be substituted with R' or Ar'R'-”.

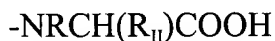
However, there is no support in the specification for this limitation, or for the definition of

R' or Ar'R'-. Applicants have attempted to carve out a genus that did not exist before. One option would be to limit R₈ to just "R" and "Ar-R". If new matter can be avoided, there would be another option, which is that the claim could recite that "Y" can be substituted with unsubstituted alkyl; but if this constitutes new matter, then that would not be an option.

※

Claims 22-73 are rejected under 35 U.S.C. §112 second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

- In claim 22, variable "Z" is defined. One of the possibilities for "Z" is the following:



Note that this contains a variable "R₁₁". However, this variable ("R₁₁") is never defined. What is defined instead is R₁₁. This appears to be an unintentional typographical error, but should be corrected.

- Claim 68 is objectionable on two grounds. First, the structure is incomplete. Second, with regard to stereochemistry, the geometry of just one of the four groups bonded to the chiral carbon is specified (the group C[R₃(R₄)R₅]), and one is implied (the hydrogen atom that is bonded to the chiral carbon). However, the relative position of the remaining two groups is not specified, and so the chiral carbon could be either "R" or "S"; it cannot be determined. The same criticisms apply in the case of claim 70.
- Each of claims 73 and 74 is dependent on a cancelled claim (claim 1).

※

The following is a quotation of the appropriate paragraphs of 35 U.S.C §102 that form the

basis for the rejections under this section made in this action.

A person shall be entitled to a patent unless -

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2) and (4) of section 371(c) of this title before the invention thereof by the applicant for the patent.

Claims 22-26, 60, 62, 68-70 are rejected under 35 U.S.C. §102(e) as being anticipated by Webber (USP 6,214,799).

As indicated previously, Webber teaches various compounds falling within the scope of claim 22. For example, at col 18, line 20+ a compound is taught. This corresponds to applicants' substituent variables as follows:

Y = -CH(R)CH=CH- wherein "R" is the side chain of glutamine;
Z = -O-C₂H₅;
R₈ = hydrogen;
R₇ = benzyl;
R₆ = hydrogen;
R₃ = hydrogen;
R₅ = hydrogen;
R₄ = alkyl;
R₁ = hydrogen;
R₂ = a benzyl group that is "substituted" with oxo (resulting in a benzoyl group)

Applicants' proviso in claim 22 is noted. What is now stated is the following:

"if R₈ is hydrogen, Y may only be substituted with R' or Ar'R'-".

Applicants' substituent variable R' can be a linear "skeleton" that contains 1-10 carbon atoms. However, the term "skeleton" is not rigorously defined in the mind of the skilled organic chemist. The term is perhaps used from time to time, but there is not exact definition. In the instant case, the "skeleton" contains 3 carbon atoms, one oxo group, and one amino group (i.e., the side chain of glutamine).

This ground of rejection could be overcome by amending the claims to recite that R' is an unsubstituted alkyl group. (No determination has been made as to what might, or might not constitute new matter).

The rejection is maintained.

*

References C9 and C10 were stricken from the IDS. The following two conditions were not met: (a) the citation is complete; this includes the year of publication, and (b) the citation is in English.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to David Lukton whose telephone number is 703-308-3213. The examiner can normally be reached Monday-Friday from 9:30 to 6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christopher Low, can be reached at (703) 308-2923. The fax number for the organization where this application or proceeding is assigned is 703-872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0196.



DAVID LUKTON
PATENT EXAMINER
GROUP 1800